

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

**Daniel P. Baumberger**

Application No.: 10/722,841

Filed: November 25, 2003

For: VIRTUAL DIRECT MEMORY ACCESS  
CROSSOVER

Examiner: Eric Charles Wai

Art Unit: 2195

Confirmation No.: 8180

Attorney Docket No.: 42P18131

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Commissioner For Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

All pending claims of the above-identified application were finally rejected in a Final Office Action mailed February 20, 2009. Applicant requests review of the final rejection for the reasons stated in the following remarks. This request is being filed concurrently with a Notice of Appeal under 35 U.S.C §134. No amendments are being filed with this request.

This request is organized as follows:

Remarks begin on page 2 of this paper.

I hereby certify that this correspondence is being deposited via  
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/Donna Jo Coningsby/

Donna Jo Coningsby, Reg. No. 41,684

**EFS FILED: MAY 20, 2009**

## REMARKS

The main subject matter of this Request is the rejection of Claims 1-20 and 31-61 under 35 USC §103(a) in a Final Office Action dated February 20, 2009. Specifically, the Examiner has rejected Claims 1-2 and 11-12 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 7,111,303 issued to Macchiano et al. (“Macchiano”). The Examiner has rejected Claims 3-10, 13-20 and 31-61 under 35 USC §103(a) as being unpatentable over Macchiano in view of Applicant’s Admitted Prior Art (“AAPA”).

### **Claims 1-2 and 11-12**

In rejecting Claims 1-2 and 11-12, the Examiner bases his argument of obviousness on a modification of a single reference, namely the modification of the Macchiano reference. The Examiner concedes that Macchiano does not explicitly teach the use of a shared physical memory element as recited in the independent Claims 1 and 11 (Office Action dated 2/20/2009, Page 3, Para no. 5). The Examiner initially argues that “Macchiano does teach the use of internal buffer storage for data transfers on the virtual LAN,” and concluded that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention that internal buffer storage *is in fact a shared physical memory element.*” (Final Office Action dated 2/20/2009, Page 3, Para no. 5, citing Macchiano, Col. 5, Lines 23-25) (Emphasis added by Applicant)

In the same Action, in a contradictory statement, the Examiner later states that “the internal buffer storage *is not inherently a shared physical memory element.*” (Final Office Action dated 2/20/2009, Page 18) (Emphasis added by Applicant). The Examiner then explains that “[t]he internal buffer storage of Macchiano is used to facilitate transfers between virtual NICs operating on the virtual LAN. Since any virtual NIC is

permitted to use this internal buffer storage, this storage (i.e. memory) is shared amongst the virtual NICs. As such,” the Examiner reasons, “Macchiano’s internal buffer storage *can be interpreted to be a shared physical memory element.*” (Final Office Action, 2/20/2009, Page 19) ((Emphasis added by Applicant).

The Examiner’s argument that Macchiano’s internal buffer storage as “*in fact*” a shared physical memory element, and then subsequent argument that it is not “*inherently*” a shared physical memory element, but rather, can be “*interpreted to be*” a shared physical memory element, is not supportable. As noted in Applicant’s timely filed 4/21/2009 response, the Examiner’s conclusion regarding Macchiano’s internal buffer storage is, at best, an impermissible hindsight influenced by knowledge of the Applicant’s disclosure, and is not properly based on the prior art.

**CLAIM 3-10, 13-20, 31-61**

In rejecting Claims 3-10, 13-20 and 31-61, the Examiner bases his argument of obviousness on Macchiano in view of Applicant Admitted Prior Art (“AAPA”). The rejection is essentially based on the same rationale as the rejection of Claims 1-2 and 11-12 – namely, that the internal buffer storage of Macchiano discloses a shared physical memory element as recited in the independent claims. As noted in Applicant’s timely filed 4/21/2009 response, there is nothing in Macchiano that indicates that the internal buffer storage is a shared physical memory element, and the Examiner has failed to demonstrate how the remaining disclosure in the AAPA would cure this deficiency in Macchiano.

**Examiner fails to show proper motivation for making a modification in a rejection under Section 103**

There are a number of errors evident in the above conclusory statements by the Examiner. Most notably, the statements made by the Examiner are contradictory. Moreover, the Macchiano reference does not teach any technology for shared physical memory elements, particularly the use of shared physical memory elements in the context of virtual machines. Rather, the teaching of Macchiano is unarguably directed to a virtual local area network (VLAN) without regard to the use of shared physical memory elements. As such, the Examiner's stated rationale for making the rejection is not supported. The Examiner has failed to show proper motivation for making a modification in an obviousness rejection under Section 103.

**Limitations not met by Macchiano or AAPA**

The Examiner has failed to demonstrate how either Macchiano or the AAPA teaches a shared physical memory element as recited in the claims. Despite the contradictory nature of the Examiner's statements, it appears that the Examiner has conceded that Macchiano does not teach the use of a shared physical memory element. But the Examiner has also failed to explain how the AAPA teaches the use of a shared physical memory element. For at least this reason, therefore, the shared physical memory element limitations of the claims are not met by either Macchiano or the AAPA.

### CONCLUSION

For at least the foregoing reasons, Applicant submits that the rejection by the Examiner of Claims 1-20 and 31-61 under Section 103 in the Final Office Action dated 2/20/2009 is improper, and respectfully requests that the rejection be withdrawn. Applicant further submits that Claims 1-20 and 31-61, as presently presented, are in condition for allowance and such action is earnestly solicited. The panel of reviewers considering this Request is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP**

May 20, 2009  
Date

/Donna Jo Coningsby/  
Donna Jo Coningsby  
Reg. No. 41,684  
Attorney for Applicant(s)

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(503) 439-8778